



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,876	07/11/2001	Mauro Premutico	1212	9166

7590

05/31/2005

HIMANSHU S. AMIN
AMIN & TUROCY, LLP
24TH FLOOR NATIONAL CITY CENTER
1900 EAST 9TH STREET
CLEVELAND, OH 44114

EXAMINER

NAWAZ, ASAD M

ART UNIT

PAPER NUMBER

2155

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,876

Applicant(s)

PREMUTICO, MAURO

Examiner

Asad M. Nawaz

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-44 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 14 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

30-2

Response to Amendment

1. This action is responsive to the amendment filed on February 14, 2005.

Claims 1-44 are presented for examination.

Drawings

2. The corrected drawings filed on February 14, 2005 have been entered and alleviate any outstanding objections.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 9-19, 23-30, 34-37, and 41-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Horstmann et al (US Patent No. 6,779,022).

As to claim 1, Horstmann teaches a method for replying to a message from a designated device in an automated messaging system, the message being sent by a sender to an address associated with a host computer, said method comprising the steps of: a) configuring the host computer to forward messages to an address associated with the designated device; (Abstract)

Art Unit: 2155

b) sending a forwarded message from the host computer to said address associated with the designated device, said forwarded message being associated with the message sent to the address associated with the host computer; (Abstract; col 4, lines 8-18)

c) receiving the forwarded message on the designated device; (Abstract)

d) sending a reply message from the designated device to the sender, wherein the reply message includes originating information and wherein the originating information of the reply message is configured using information associated with the host computer; (Abstract; Fig 4; col 2, lines 38-41; col 5, lines 21-56; col 6, lines 1-16) and

e) sending a copy message from the designated device to the address associated with the host computer, said copy message being associated with the reply message. (Fig 4; Col 6, 1-16)

Claims 13, 16, 27, and 34 are rejected for containing similar limitations as claim 1 above.

As to claim 2, Horstmann teaches the method of claim 1 wherein the copy message includes recipient information and wherein the recipient information of the copy message is configured using information associated with the sender. (Abstract; Fig 4; col 2, lines 38-41; col 5, lines 21-56; col 6, lines 1-16)

Claims 14, 17, 28, and 35 are rejected for containing similar limitations as claim 2 above.

As to claim 3, Horstmann teaches the method of claim 1 wherein the forwarded message includes originating information and wherein the originating

Art Unit: 2155

information of the forwarded message is configured using information associated with sender. (Abstract; Fig 4; col 2, lines 38-41; col 5, lines 21-56; col 6, lines 1-16)

Claims 15, 18, 29, and 36 are rejected for containing similar limitations as claim 3 above.

As to claim 4, Horstmann teaches the method of claim 1 wherein the message sent to the address associated with the host computer is in a first file format and wherein the forwarded message is in a second file format, and wherein the method further comprises converting the first file format to the second file format. (abstract, col 1, lines 55-69)

Claims 19, 30, and 37 are rejected for containing similar limitations as claim 4 above.

As to claim 9, Horstmann teaches the method of claim 1 wherein the host computer only forwards messages of a certain type to the designated device. (Abstract; col 5, lines 57-67)

Claims 23 and 41 are rejected for containing similar limitations as claim 9 above.

As to claim 10, Horstmann teaches the method of claim 1 wherein the designated device is a mobile device. (Abstract, Fig 1, col4, lines 36-46)

Claims 24 and 42 are rejected for containing similar limitations as claim 10 above.

As to claim 11, Horstmann teaches the method of claim 1 wherein the message sent to the address associated with the host computer is an email message. (Abstract)

Art Unit: 2155

Claims 25 and 43 are rejected for containing similar limitations as claim 11 above.

As to claim 12, Horstmann teaches the method of claim 1 wherein the reply message is an email message. (Abstract)

Claims 26 and 43 are rejected for containing similar limitations as claim 12 above.

Response to Arguments

5. Applicant's arguments with respect to claims 1-44 filed February 14, 2005 have been fully considered but they are not persuasive.

6. In substance, the applicant argues that Horstmann et al does not disclose providing the host computer with a copy of an original message and is silent with regards to this aspect of the instant application.

7. In response to the applicant's argument, Horstmann et al discloses that a copy of the original message is retained at the host and that the user can use their wireless device to forward the original message to another device. (Abstract, col 1, lines 47-66) Therefore, there is disclosed at the very least the user's capability to forward/reply to any entity desired. However, Horstmann et al is not silent to this fact. Horstmann et al further discloses that the host receives the reply message. This reply message is, therefore, associated with the reply message that was sent to the original sender. There is no further limitation in the claim as presented that recites what the host does with the reply message (i.e. stores it). (Fig 4. and col 6, lines 1-16)

Art Unit: 2155

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action:

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asad M. Nawaz whose telephone number is (571) 272-3988. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2155

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


AMN


SALEH NAJJAR
PRIMARY EXAMINER